



PROPRIETARY – DO NOT SCAN

ATTORNEY'S DOCKET NUMBER: 2009186-0030

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Applicant: Zhu *et al.*
Serial. No.: 09/603,658
Filed: June 23, 2000
Title: HIGHLY DIVERSE LIBRARY OF YEAST EXPRESSION VECTORS

Examiner: Friend, Tomas
Art Unit: 1627
Conf. No.: 2796

JUL 11 2011

OFFICE OF PETITIONS

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 CFR 1.59(b) TO EXPUNGE
INFORMATION SUBMITTED UNDER MPEP § 724.02 AND/OR
INFORMATION UNINTENTIONALLY SUBMITTED IN AN APPLICATION

Petitioner submits this Petition under 37 CFR 1.59(b) to expunge information under MPEP § 724.02 or that should have been submitted under MPEP § 724.02. Petitioner submits that the information requested to be expunged is not material to patentability, and therefore qualifies for expungement under MPEP §§ 724.02 and 724.05(I).

Pursuant to MPEP § 724.05(I), the information to be expunged is the following:

- i. The three-page Schedule A appended to the Power of Attorney document filed in the instant case on May 16, 2011;
- ii. This Petition under 37 CFR 1.59(b);
- iii. The Office's Decision on this Petition under 37 CFR 1.59(b);
- iv. The accompanying Petition under 37 CFR 1.183 (7 pages); and
- v. The Office's Decision on the Petition under 37 CFR 1.183.

Pursuant to MPEP § 724.05(I), the information contained in Schedule A of the Power of Attorney filed May 16, 2011, is proprietary material because a) it comprises a listing of Petitioner's intellectual property as filed with the USPTO, and b) identifies certain proprietary information that is not available to the public. Had Petitioner submitted such proprietary information in a sealed envelope in the filing of May 16, 2011, it would have been accompanied by a Petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02.

Therefore, the present submission of this Petition under 37 CFR 1.59(b) to expunge information that should have been submitted under MPEP § 724.02, is proper. Petitioner requests expungement of the entire Schedule A document.

In addition to the proprietary information contained in the Schedule A document filed on May 16, 2011, the instant Petitions under 37 CFR 1.59(b) and 37 CFR 1.183 also contain proprietary information because they identify the presence and location of other proprietary information in the public file wrapper. If the instant Petitions under 37 CFR 1.59(b) and 37 CFR 1.183 are made available to the public prior to expungement of the Schedule A document filed on May 16, 2011, the public will be notified of both the existence and location of Petitioner's proprietary information. Therefore, Petitioner also requests expungement of these Petitions and the Office's Decision on the Petitions. At a minimum, Petitioner requests that the Office not enter into the file wrapper the instant Petitions or Decisions thereon prior to expungement of the Schedule A document filed in the instant case on May 16, 2011.

Pursuant to MPEP § 724.05(I), Petitioner will retain the expunged information for the period of any patent that may issue from the instant application.

Pursuant to MPEP § 724.05(I), this Petition under 37 CFR 1.59(b) is submitted by, on behalf of, the party in interest who submitted the Power of Attorney filed May 16, 2011.

Pursuant to MPEP § 724.05(I), this Petition under 37 CFR 1.59(b) is accompanied by the fee as set forth in 37 CFR 1.17(g).

Alternatively, Petitioner submits this Petition under 37 CFR 1.59(b) to expunge information unintentionally submitted in an application. Petitioner submits that the information requested to be expunged is not material to patentability, and therefore qualifies for expungement under MPEP § 724.05(II).

Pursuant to MPEP § 724.05(II), the information to be expunged is the following:

- i. The three-page Schedule A appended to the Power of Attorney document filed in the instant case on May 16, 2011;
- ii. This Petition under 37 CFR 1.59(b);
- iii. The Office's Decision on this Petition under 37 CFR 1.59(b);
- iv. The accompanying Petition under 37 CFR 1.183 (7 pages); and
- v. The Office's Decision on the Petition under 37 CFR 1.183.

As explained above, the information contained in Schedule A of the Power of Attorney filed May 16, 2011, is proprietary material because a) it comprises a listing of Petitioner's intellectual property as filed with the USPTO, and b) identifies certain proprietary information that is not available to the public. The proprietary information of Schedule A was unintentionally submitted as part of the Power of Attorney filed May 16, 2011, and thus the failure to expunge this information from the file wrapper of the instant case would cause irreparable harm to the party in interest on whose behalf the information was submitted.

Pursuant to MPEP § 724.05(II), the instant application has not yet issued as of the filing date of this Petition, and therefore qualifies for expungement under MPEP § 724.05(II).

Pursuant to MPEP § 724.05(II), this Petition under 37 CFR 1.59(b) is submitted by, on behalf of, the party in interest who submitted the Power of Attorney filed May 16, 2011.

Pursuant to MPEP § 724.05(II), this Petition under 37 CFR 1.59(b) is accompanied by the fee as set forth in 37 CFR 1.17(g).

It is Petitioner's understanding that there are no additional fees associated with the present submission beyond the fee under 37 CFR 1.17(g). Should this understanding be in error, Petitioner respectfully requests notification and itemization of any fees that the USPTO believes should be charged. Any such fees that are *essential* to acceptance of the present Petition as complete and timely filed may be Charged to Deposit Account No. 03-1721. Please do not charge any other fees associated with the above-referenced Deposit Account absent explicit instructions with respect to the particular fee. Overpayments may be credited to the Deposit Account at any time.

Respectfully submitted,

Dated: July 5, 2011

/ Brenda Herschbach Jarrell /
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Sir:

PETITION UNDER 37 CFR § 1.183 AND/OR
SUBMISSION UNDER 37 CFR § 1.217(d)

Petitioner hereby requests that 37 CFR §§ 1.217(d) and 1.59 be waived and that the Petition under 37 CFR § 1.59(b) filed concurrently herewith be treated on its merits.

Alternatively, Petitioner requests redaction under 37 CFR § 1.217(d)

The instant application issued as U.S. Pat. No. 6,410,246 ("the '246 patent") on June 25, 2002. Petitioner submits herewith a Petition under 37 CFR § 1.59(b) for expungement of information or copy of papers in an application. Specifically, this Petition under 37 CFR § 1.59(b) requests expungement of (i) the three-page Schedule A appended to the Power of Attorney document filed in the instant case on May 16, 2011, (ii) the accompanying Petition under 37 CFR 1.59(b), (iii) the Office's Decision on the Petition under 37 CFR 1.59(b), (iv) this Petition under 37 CFR 1.183, and (v) the Office's Decision on this Petition. As set forth in the Petition under 37 CFR § 1.59(b), expungement is proper because the information contained in Schedule A of the Power of Attorney filed May 16, 2011 is proprietary material because it (i) comprises a listing of Petitioner's intellectual property as filed with the USPTO and (ii) identifies certain proprietary information that is not available to the public.

However, rule 37 CFR § 1.59(b) is directed on its face to expungement of information in an application file. The present file has issued as a patent and is therefore not an application file. Petitioner therefore submits the present Petition under 37 CFR § 1.183 and/or submission under 37 CFR § 1.217(d) to request that the requirement under 37 CFR § 1.59(b) that materials be

submitted in an *application* file be waived and/or that information be redacted under 37 CFR § 1.217(d), rather than expunged under 37 CFR § 1.59(b), from the present file.

The requested relief is justified because, notwithstanding that the ‘246 patent is no longer a pending application, Petitioner respectfully submits that (i) information contained in the Schedule A document is proprietary and Petitioner is entitled under 37 CFR § 1.59 and/or 37 CFR § 1.217(d) to remove this material from the public file wrapper, (ii) in no event could Petitioner have requested redaction or expungement prior to allowance or issue of the ‘246 patent because the proprietary information was filed more than eight years after the ‘246 patent issued, and (iii) and requirements of 37 § C.F.R 1.217(c)(1) and the certification of 37 § C.F.R 1.217(d)(3) do not apply in the instant case because there is no redacted copy of the application being submitted.

Pursuant to 37 CFR § 1.217(d), Petitioner includes herewith (i) a copy of the Schedule A filed May 16, 2011, showing the desired redactions, and (ii) a second copy of the Schedule A filed May 16, 2011, showing the redacted material in brackets.

Petitioner thanks the Director for careful consideration of this Petition and respectfully requests that the Petition be favorably acted upon.

The Petition fee under 37 CFR § 1.17(f) is submitted herewith. As a fee under 37 CFR § 1.17(g) is already being submitted for the Petition under 37 CFR 1.59(b), Petitioner has not submitted the fee for redaction under 37 CFR § 1.17(i). In the event the fee under 37 CFR § 1.17(i) is required, Petitioner requests that the fee paid under 37 CFR § 1.17(g) be applied and the balance deposited to Petitioner’s Deposit Account No. 03-1721. Alternatively, the fee under 37 CFR § 1.17(i) may be charged to Petitioner’s deposit account and the fee under 37 CFR § 1.17(g) refunded.

Any such fees that are *essential* to acceptance of the present Petitions as complete and timely filed may be Charged to Deposit Account No. 03-1721. Please do not charge any other fees associated with the above-referenced Deposit Account absent explicit instructions with respect to the particular fee. Overpayments may be credited to the Deposit Account at any time.

Respectfully submitted,

Dated: July 5, 2011

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SCHEDULE A

Application No. (Patent No.)	Filing Date (Issue Date)	Title	Attorney Docket No.
[09/602373 (6,410,271)	June 23, 2000 (June 25, 2002)	GENERATION OF HIGHLY DIVERSE LIBRARY OF EXPRESSION VECTORS VIA HOMOLOGOUS RECOMBINATION IN YEAST	2009186-0026
09/602972	June 23, 2000	METHODS FOR SCREENING A HIGHLY DIVERSE LIBRARY OF PROTEINS IN YEAST	2009186-0027
10/112691	March 27, 2002	GENERATION OF HIGHLY DIVERSE LIBRARY OF EXPRESSION VECTORS VIA HOMOLOGOUS RECOMBINATION IN YEAST	2009186-0028]
09/603658 (6,410,246)	June 23, 2000 (June 25, 2002)	HIGHLY DIVERSE LIBRARY OF YEAST EXPRESSION VECTORS	2009186-0030
[09/603663 (6,406,863)	June 23, 2000 (June 18, 2002)	HIGH THROUGHPUT GENERATION AND SCREENING OF FULLY HUMAN ANTIBODY REPERTOIRE IN YEAST	2009186-0031
10/112612	March 27, 2002	HAPLOID YEAST CELLS TRANSFORMED WITH A LIBRARY OF EXPRESSION VECTORS ENCODING A FULLY HUMAN ANTIBODY REPERTOIRE	2009186-0032
10/792682	March 2, 2004	HIGH THROUGHPUT GENERATION AND SCREENING OF FULLY HUMAN ANTIBODY REPERTOIRE IN YEAST	2009186-0033
09/703399 (6,610,472)	October 31, 2000 (August 26, 2003)	ASSEMBLY AND SCREENING OF HIGHLY COMPLEX AND FULLY HUMAN ANTIBODY REPERTOIRE IN YEAST	2009186-0034
10/423495	April 24, 2003	ASSEMBLY AND SCREENING OF HIGHLY	2009186-0035

Application No. (Patent No.)	Filing Date (Issue Date)	Title	Attorney Docket No.
		COMPLEX AND FULLY HUMAN ANTIBODY REPERTOIRE IN YEAST	
10/947610	September 21, 2004	ASSEMBLY AND SCREENING OF HIGHLY COMPLEX AND FULLY HUMAN ANTIBODY REPERTOIRE IN YEAST	2009186-0036
60/403296	August 12, 2002	HIGH THROUGHPUT GENERATION AND AFFINITY MATURATION OF HUMANIZED ANTIBODY	2009186-0038
10/460595	June 11, 2003	HIGH THROUGHPUT GENERATION AND AFFINITY MATURATION OF HUMANIZED ANTIBODY	2009186-0039
11/480037	June 29, 2006	HIGH THROUGHPUT GENERATION AND AFFINITY MATURATION OF HUMANIZED ANTIBODY	2009186-0040
10/071866	February 8, 2002	HIGH THROUGHPUT GENERATION OF HUMAN MONOCLONAL ANTIBODY AGAINST PEPTIDE FRAGMENTS DERIVED FROM MEMBRANE PROTEINS	2009186-0042
10/133978	April 25, 2002	METHODS FOR GENERATING MONOCLONAL ANTIBODY AGAINST FUSION PROTEIN CONTAINING PEPTIDE FRAGMENT DERIVED FROM MEMBRANE PROTEIN	2009186-0044
10/988485	November 12, 2004	METHODS FOR GENERATING MONOCLONAL ANTIBODY AGAINST FUSION PROTEIN CONTAINING PEPTIDE FRAGMENT DERIVED FROM MEMBRANE PROTEIN	2009186-0045
11/593957 (7,700,302)	November 6, 2006 (April 20, 2010)	METHOD FOR GENERATING AND SELECTING ANTIBODIES AGAINST TARGET PROTEIN	2009186-0047

Application No. (Patent No.)	Filing Date (Issue Date)	Title	Attorney Docket No.
12/713357	February 26, 2010	METHOD FOR GENERATING AND SELECTING ANTIBODIES AGAINST TARGET PROTEIN	2009186-0048
61/119831	December 4, 2008	NOVEL ABCB5 EPITOPE AND NOVEL ANTIBODIES THERETO FOR THE TREATMENT OF CANCER	2009186-0053
60/993785	September 14, 2007	RATIONALLY DESIGNED SYNTHETIC PREIMMUNE HUMAN ANTIBODY LIBRARY AND USES THEREFOR	2009186-0006
12/210072	September 12, 2008	RATIONALLY DESIGNED, SYNTHETIC ANTIBODY LIBRARIES AND USES THEREFOR	2009186-0007
61/365194	July 16, 2010	ANTIBODY LIBRARIES	2009186-0010
12/404059	March 13, 2009	RATIONALLY DESIGNED SYNTHETIC ANTIBODY LIBRARIES AND USES THEREFOR	2009186-0015
12/255311	October 21, 2008	COMPOSITIONS AND METHODS FOR PRESENTATION OF PROTEINS VIA CELL SURFACE CAPTURE	2009186-0024
60/283617	April 13, 2001	Genetastic Affinity Maturation	2009186-0055
60/982,640	October 25, 2007	Generation and Selection of Library of Proteins via Cell Surface Capture	2009186-0005]

SCHEDULE A

<u>Application No.</u> (Patent No.)	<u>Filing Date</u> (Issue Date)	<u>Title</u>	<u>Attorney Docket No.</u>
09/603658 (6,410,246)	June 23, 2000 (June 25, 2002)	HIGHLY DIVERSE LIBRARY OF YEAST EXPRESSION VECTORS	2009186-0030